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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/963,876	09/25/2001	Marilyn E. Shade	07844-470001 / P434	9189
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FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA MINNEAPOLIS, MN 55402			EXAMINER AMINI, JAVID A	
			ART UNIT 2672	PAPER NUMBER
			DATE MAILED: 02/20/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/963,876

Applicant(s)

SHADE ET AL.

Examiner

Javid A Amini

Art Unit

2672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on December 17, 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

Applicant's arguments filed December 17, 2003 have been fully considered but they are not persuasive.

- Applicant on page 5 of remarks, lines 1-18 argues that the reference Kim does not disclose an icon for controlling display/non-display of at least one reference line. Examiner's reply: An icon is a small image displayed on the screen to represent an object that can be manipulated by the user. The reference in Fig. 5 illustrates a preview for controlling display of at least one reference line (ABCabc) with the composite font of text displayed. A user can manipulate different font/size/style from a small image displayed (icon).
- Applicant on page 6 lines 1-22 argues that the Examiner asserts the step of displaying "sample text ... in a plurality of lines", as now recited in claim 4, is inherent in Kim. For inherency to exist, it must be clear that the missing descriptive matter is necessarily present in the reference. Examiner's reply: Kim in col. 2, lines 7-8 discloses Corel DRAW 7 and Word Perfect 8, which they have under toolbars a formatting option that includes icon for controlling display/non-display of different fonts.
- Applicant on pages 6-7 lines 23-29; 1-26 argues that the second reference Patel does not teach the limitations of claim 2. See col. 1, lines 44-54, Patel 's invention provides methods and apparatus that process a front-end editable text file--which will be referred to as a feature file--that a user (such as a font editor) can use to

define changes to an existing font file, such as an OpenType.TM. font file, or to create a font file. The feature file contains simple logic statements for the specification of various typographical features, such as layout features, that may enhance or supplement a source font. The feature file may contain override values for fields in font tables. The feature file can be processed in combination with an existing font file to establish an enhanced font file. Also see col. 85 lines 11-25 under the Horizontal Header table, the limitations of Ascender, Descender. Patel in col. 84 line 41 teaches the limitation of baseline, Patel in col. 24 line 40 teaches the limitation of XHeight and CapHeight. Patel in col. 88 lines 25-32 teaches sxHeight, sCapHeight, usDefaultChar, usBreakChar, usMaxContext. Patel in cols. 89-90 lines 40-67; 1-47 teaches the limitations of ascent, decent. Applicant in claim 3 argues that the reference line displayed in different color, but does not explicitly specify, how does the different color display? The motivation to combine the reference Patel into Kim is as following: Patel's invention provides methods and apparatus that process a front-end editable text file--which will be referred to as a feature file--that a user (such as a font editor) can use to define changes to an existing font file, such as an OpenType.TM. font file, or to create a font file. And Kim's invention provides effectively making up a document for a user by promptly showing a desirable font sample, when the user makes up a document. Now by combining these two inventions the OpenType fonts include a variety of tables, and optionally include OpenType Layout tables,

which allow font creators to design better international and high-end typographic fonts.

- Examiner suggestion: The claim languages need to explicitly specify the claim invention by narrowing down the limitations.
- For the above reasons, the pervious rejection is still maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4, 5 and 8-10 rejected under 35 U.S.C. 102(e) as being anticipated by Kim.

1. Claim 1.

A composite font editing device used in a desktop publishing (DTP) system, comprising:

The step is inherent because Kim illustrates in Figs. 6-7B “a composite font editor operable to select two or more different fonts and create a composite font”; Kim in abstract teaches the step of “wherein the composite font editor is operable to display a composite font dialog box on the screen of a display device, the composite font dialog box” Kim in fig. 5 teach the step of “displaying a sample window containing sample text using the composite font, and wherein an icon is provided for controlling display/nondisplay of at least one reference line associated with the composite font of the sample text displayed in the sample window.

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2. Claim 4.

The step is inherent because an editing device can convert number of text lines to any type of fonts available to the user in the windows environment. “wherein the sample text is displayed in the sample window in a plurality of lines”.

3. Claim 5.

Kim in (col. 1, lines 25-30), the step of “A computer program product, tangibly stored on a computer-readable medium, for composite font editing, comprising instructions operable to cause a programmable processor to”: The step is inherent because Kim illustrates in Figs. 6-7B “display a composite font editing dialog box on the screen of a display device when started by a user”; the step is inherent see Kim Figs. 2 and 3, “select two or more different fonts, using the composite font editing dialog box, to create a composite font; Kim in fig. 5 teach the step of use the created composite font to display sample text in a sample window; Kim in Fig. 5 teach the step of “display a reference line of the selected reference line icon in the sample window in response to a user selection of at least one reference line icon provided in the composite font editing dialog box”.

4. Claim 8.

The step is inherent because an editing device can convert number of text lines to any type of fonts available to the user in the windows environment. “further operable to display sample text in the sample window as a plurality of textual lines when the sample text includes a plurality of characters”.

5. Claim 9.

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Kim in (col. 1, lines 25-30), the step of “A composite font editing device used in a desktop publishing system, comprising: a font file storing a plurality of different fonts”; The step is inherent because Kim illustrates in Figs. 6-7B “a composite font editing means for selecting two or more fonts from the plurality of different fonts and creating a composite font”; Kim in Fig. 5 teach the step of “when the composite font editing means is started by user input, a composite font dialog box is displayed on the screen of a display device, the composite font dialog box being operable to display a sample window displaying sample text using the composite font, and an icon is provided for controlling display/nondisplay of at least one reference line associated with the composite font of the sample text displayed in the sample window”.

6. Claim 10.

A computer readable recording medium storing a composite font editing program, for executing by computer in a desktop publishing system, comprising:

Kim in Fig. 5 teach the step of “a procedure for displaying a composite font editing dialog box on a screen of a display device when started by a user”; Kim in (col. 1, lines 25-30), the step of “a procedure for selecting two or more different fonts using the composite font editing dialog box and creating a composite font”; Kim in fig. 5 teach the step “a procedure for using the created composite font to display sample text in a sample window”; Kim in Fig. 5 teach the step of “a procedure for displaying the reference line of the selected reference line icon in the sample window when a user selects at least one reference line icon provided in the composite font editing dialog box”.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 3, 6 and 7 rejected under 35 U.S.C. 103(a) as being unpatentable over Kim, and further in view of Patel et al.

7. Claim 2.

Kim does not explicitly specify, however, Patel et al. in (col. 1, lines 18-40) teach the step of “wherein the reference line has at least one line selected from: ICF box (average type face), embox (virtual body), baseline, cap height, ascent, descent, ascender, and X height”.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Patel et al. into Kim in order to eliminate the details of the underlying data structures. The user can use language constructs that are not limited to a one-to-one correspondence with font data structures. The appropriate format of sub tables is automatically selected. Modification to the font is made in a manner that facilitates efficient file storage. Optimizations are performed on shared data, which reduces the size of the font.

8. Claim 3.

The step is obvious because Kim in Fig. 5 introduces the WordPerfect 8 application that provides different types of font and can be selected with different color. “Wherein each reference line is displayed in a different color when a plurality of the reference lines is displayed”.

9. Claim 6.

Kim does not explicitly specify, however, Patel et al. in (col. 1, lines 18-40) teach the step of “wherein the reference line icon has at least one reference line icon selected from: ICF box (average type face), em-box (virtual body), baseline, cap height, ascent, descent, ascender, and X height. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Patel et al. into Kim in order to eliminate the details of the underlying data structures. The user can use language constructs that are not limited to a one-to-one correspondence with font data structures. The appropriate format of sub tables is automatically selected. Modification to the font is made in a manner that facilitates efficient file storage. Optimizations are performed on shared data, which reduces the size of the font.

10. Claim 7.

The step is obvious because Kim in Fig. 5 introduces the WordPerfect 8 application that provides different types of font and can be selected with different color. “further operable to display each reference line in a different color when a plurality of the reference lines is displayed”.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javid A Amini whose telephone number is 703-605-4248. The examiner can normally be reached on 8-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 703-305-4713. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Javid A Amini
Examiner
Art Unit 2672

Javid Amini


JEFFERY BRIEN
PRIMARY EXAMINER